

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

M. VIKRAM RAO

Serial No.: **10/631,954**

Filed: **JULY 30, 2003**

Title: **"IMPROVED PARTICULATES AND
METHODS OF UTILIZING THESE
PARTICULATES IN SUBTERRANEAN
APPLICATIONS"**

§ Group Art Unit: **1773**

§

§ Examiner: **LE, HOA T.**

§

§

§ Atty. Docket No: **2003-IP-010829U1**

§

CERTIFICATE OF FILING ELECTRONICALLY VIA EFS
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HONORABLE COMMISSIONER FOR PATENTS
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APPELLANT'S REPLY BRIEF (37 C.F.R. § 41.41)

This reply brief is submitted in response to the Examiner's Answer dated May 16, 2007, and in further support of Appellant's Notice of Appeal from the rejections in the Final Office Action dated May 12, 2006 (the "Final Office Action"), the Advisory Action dated August 10, 2006 (the "Advisory Action"), and the Notice of Panel Decision from Pre-Appeal Brief Review dated November 15, 2006.

Pursuant to 37 C.F.R. § 41.41, the period for filing this Reply Brief is two months from the date of the Examiner's Answer, which is July 16, 2007. Therefore, this Reply Brief is timely filed.

Appellant files this Reply Brief to respond to certain points of argument in the Examiner's Answer regarding the rejections of claims 1-17 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,913,643 to Dejaiffe ("Dejaiffe").¹

I. ARGUMENT

A. Evidence cited in Appellant's Brief shows that the processes disclosed in *Dejaiffe* do not inherently produce particulates having "a substantially spherical shape."

In rejecting Appellant's claims, the Examiner explicitly relies on the assumption that the substantially spherical shape of the particulates "is a necessarily inherent product" of the process of "heating a mixture of glass and foaming agent in the presence of oxygen" (i.e., sintering) and "pelletizing and firing the glass composition to form the aggregates" disclosed in *Dejaiffe*. (Examiner's Answer at 5.) The Examiner's most recent reliance upon certain dictionaries that define pellets as having substantially spherical shape simply does not carry the burden required to show that this characteristic would be inherent in *Dejaiffe*. (Examiner's Answer at 6.) While these definitions may indicate that certain pellets may have substantially spherical shapes, they do not indicate that the pellets made in *Dejaiffe* necessarily do.

In fact, Appellant refuted this assumption in its initial brief by citing two references showing that the processes of sintering and pelletization each produce aggregates of all different shapes, which may or may not be substantially spherical.² The Examiner attempts to distinguish these teachings simply by arguing that neither reference describes the performance of both sintering and pelletizing steps (see Examiner's Answer at 6-7), inexplicably implying that although particles produced in each of these processes may not have a substantially spherical shape, particles produced from the performance of the two steps together necessarily do. There is simply no evidence or logical explanation to support such an assumption.

Thus, the Examiner has not shown that the processes described in *Dejaiffe* will "necessarily" produce particulates having a substantially spherical shape, as required in Appellant's claims. Accordingly, *Dejaiffe* cannot anticipate Appellant's claims.

¹ A copy of *Dejaiffe* was attached as Appendix E to Appellant's Brief filed January 10, 2007.

² RANDALL M. GERMAN, SINTERING THEORY AND PRACTICE 260 (John Wiley & Sons, Inc. 1996) (discussing sintering) and U.S. Patent No. 3,125,794 at col. 3, ll. 12-17 (discussing pelletizing). Copies of these references were provided in Appendix B of Appellant's initial brief.

B. Examiner's anticipation argument is based on an improper "picking and choosing" of scattered pieces of the disclosures in *Dejaiffe* and Appellant's application and cobbling them together to practice the claimed invention.

Even if it is possible to generate Appellant's claimed particulates from some combination of the processes disclosed in *Dejaiffe*, the Examiner has only hypothesized this result by "picking and choosing" details from disconnected portions of *Dejaiffe*, Appellant's own disclosure, and a variety of dictionaries and website references having nothing to do with *Dejaiffe* or Appellant's invention. However, the Federal Circuit, its predecessor court, and the Board of Patent Appeals and Interferences have all held that, for a prior art reference to anticipate a claim, that reference "must clearly and unequivocably disclose the claimed compound or direct those skilled in the art to the compound without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." *In re Arkley*, 455 F.2d 586, 587 (C.C.P.A. 1972); *see Azko v. U.S. Internat'l Trade Comm'n*, 808 F.2d 1471, 1480 (Fed. Cir. 1986); *see, e.g., Ex parte Ruzakowski et al.*, Appeal No. 2006-2511, 2006 WL 2725748, at *2 (Bd. Pat. App. & Interf. Sept. 20, 2006); *Ex parte Johnson et al.*, Appeal No. 2006-0070, 2006 WL 1665466, at *3 (Bd. Pat. App. & Interf. Jan. 25, 2006).³ *Dejaiffe* contains no such disclosure.

Appellant's claims require a combination of several specific elements, *i.e.*, silica, an aluminum oxide in an amount of less than about 25%, and at least one void, the particulates having a specific gravity of less than about 2.2, a particle size of 8 U.S. Mesh or smaller, and a substantially spherical shape. (*See* claim 1.) Although *Dejaiffe* mentions several of these components and does not foreclose the possibility that the components may be processed to produce particulates having one or more of the requisite properties (*e.g.*, a substantially spherical shape), particulates having all of these elements are only one of numerous possible products that the *Dejaiffe* methods may produce.⁴ *Dejaiffe* does not "clearly" or "unequivocably" disclose any particular combination of steps that will necessarily generate particulates having the required shape and the other required elements, nor does it direct a person of skill in the art to perform a

³ Copies of these opinions are provided in Reply Appendix A to this Brief. Although the opinions issued in these cases are not binding precedent, they clearly demonstrate the proper analysis for determining whether a prior art reference anticipates a claim under § 102.

⁴ This would be the case even if, as the Examiner asserts, sintering and pelletizing the proper combination of starting materials "necessarily" produces particulates having a substantially spherical shape. However, as discussed in Section I.A. of this Reply Brief and in Appellant's initial brief, there is no indication that sintering and pelletizing any particular combination of materials necessarily will produce particulates of that shape.

method that will generate particulates having those properties. “Picking and choosing” descriptions of these elements from different portions of *Dejaiffe*’s disclosure and several other independent sources cannot form a proper basis for anticipating Appellant’s claims.

C. No authority cited by the Examiner permits reliance on Appellant’s description of the preferred embodiments of the invention to show that *Dejaiffe* inherently forms particulates having a “substantially spherical shape.”

As Appellant has already argued, the Examiner’s extrapolation from descriptions of preferred embodiments of Appellant’s invention to conclude that the processes disclosed in *Dejaiffe* necessarily form particulates having a substantially spherical shape is improper, as the basis in fact and/or technical reasoning supplying an inherent claim element must come from the extrinsic evidence available to a person of skill in the art. *See, e.g., Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). The Examiner does not dispute this rule of law in his Answer.

Rather, the Examiner cites *In re Omeprazole Patent Litigation*, Docket No. 04-1562 (Fed. Cir. 4/23/2007), for the unremarkable proposition that “if a layer would form in situ every time a process is followed, the layer is an inherent property of the process” (See Examiner’s Answer at 8.) However, in *In re Omeprazole*, as in many other cases finding inherent anticipation, extensive extrinsic evidence, including expert testimony in related litigation, supported the premise that the prior art would produce the claimed result “each and every time.” *See In re Omeprazole*, No. 04-1562 at 12-13; *cf. Schering Corp. v. Geneva Pharms., Inc.*, 339 F.3d 1373, 1379 (Fed. Cir. 2003) (“extensive record evidence of testing” showed that the claimed product was inherently formed in prior art). In contrast, the only “evidence” that the Examiner cites to support the hypothesis that *Dejaiffe* inherently discloses particulates having a substantially spherical shape is a single embodiment in Appellant’s specification, which itself is not properly relevant to finding inherent disclosure of that property in the prior art, as Appellant has already shown. Thus, neither *In re Omeprazole* nor any other legal precedent can support a finding that *Dejaiffe* inherently discloses particulates having a substantially spherical shape based on the scant and legally-improper evidence cited by the Examiner. *See In re Seaborg*, 51 C.C.P.A. 1109, 328 F.2d 996, 998-99 (C.C.P.A. 1964) (formation of claimed product only under certain conditions or in “undetectable” amounts did not support inherent anticipation, explicitly distinguished by the Federal Circuit in *Schering*).

Thus, since *Dejaiffe* does not disclose this element of claims 1 and 10, *Dejaiffe* does not anticipate those claims. Moreover, claims 2-9 and 11-17 each depend, either directly or indirectly, from claim 1 or 10, and thus incorporate the limitations of claim 1 or 10 that *Dejaiffe* does not disclose. Therefore, claims 1-17 are allowable over *Dejaiffe*, and Appellant respectfully requests the reversal of the rejections against these claims.

II. SUMMARY

In light of the foregoing, Appellant respectfully requests that the final rejection of the pending claims should be reversed and the application be remanded for allowance of the pending claims, or, alternatively, remand the application for further examination if appropriate references can be found by the Examiner.

Appellant believes that there are no fees due in association with this filing. However, should the Commissioner deem that any additional fees are due, including any fees for extensions of time, the Commissioner is authorized to debit Baker Botts L.L.P.'s Deposit Account No. 02-0383, Order Number 063718.0285.

Respectfully submitted,



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Date: July 13, 2007

**REPLY APPENDIX A: CITED OPINIONS OF THE BOARD OF PATENT
APPEALS AND INTERFERENCES**

Contents:

1. *Ex Parte Ruzakowski et al.*, Appeal No. 2006-2511, 2006 WL 2725748 (Bd. Pat. App. & Interf. Sept. 20, 2006).
2. *Ex parte Johnson et al.*, Appeal No. 2006-0070, 2006 WL 1665466 (Bd. Pat. App. & Interf. Jan. 25, 2006).

KeyCite Citing

Rank (R) 1 of 1

Database
FIP-PTO2006 WL 1665466 (Bd.Pat.App. & Interf.)
(Cite as: 2006 WL 1665466 (Bd.Pat.App. & Interf.))

*1 THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

Board of Patent Appeals and Interferences

Patent and Trademark Office (P.T.O.)

EX PARTE SONYA S. JOHNSON, DAVID G. BARKALOW, MICHAEL J. GREENBERG AND GLORIA
T. SHELDON

Appeal No. 2006-0070

Application No. 10/024,631

Heard: January 25, 2006

WRIGLEY & DREYFUS 28455

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P.O. BOX 10395

CHICAGO, IL 60610

Before PAK, WARREN and TIMM

Administrative Patent Judges

PAK

Administrative Patent Judge

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 22 and 25 through 38, which are all of the claims pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 134.

BACKGROUND

The subject matter on appeal relates to a coated chewing gum having a gum base or center containing, inter alia, a bicarbonate salt and a coating containing at least one medicament and either xylitol or sorbitol. See the specification, pages 4 and 5. This coated chewing gum is said to provide enhanced absorption of the medicament through oral mucosa. See the specification, page 5. Details of the appealed subject matter are recited in representative claims 1, 16, 30 and 38, which are reproduced below.

1. A coated chewing gum product with absorption acceleration of a medicament, comprising:

a) a chewing gum center comprising a gum base, a flavor, and a bulking/sweetening agent;

b) a chewing gum coating comprising a polyol selected from the group consisting of xylitol and sorbitol, and containing at least one medicament; and
c) a bicarbonate salt incorporated into the chewing gum center, the coating, or both.

16. A coated chewing gum product including a medicament comprising:

a) a chewing gum center;

b) a chewing gum coating containing at least one medicament and a polyol selected from the group consisting of xylitol and sorbitol; and

c) a bicarbonate salt incorporated into the chewing gum center, the coating, or both.

30. A method of delivering a medicament with accelerated absorption through the oral mucosa comprising the steps of:

a) providing a chewing gum center;

b) coating the chewing gum center with a coating comprising a polyol selected from the group consisting of xylitol and sorbitol, and containing at least one medicament;

(Cite as: 2006 WL 1665466, *1 (Bd.Pat.App. & Interf.))

- c) either the chewing gum center, the coating, or both incorporating a bicarbonate salt; and
- d) causing an individual in need of the medicament to chew the product.

38. A coated chewing gum product with absorption acceleration of caffeine, comprising;

- a) a chewing gum center comprising a gum base, a flavor, and a bulking/sweetening agent;
- b) a chewing gum coating comprising caffeine and a polyol selected from the group consisting of sorbitol and xylitol; and
- c) a bicarbonate salt incorporated into the chewing gum center, the coating, or both.

*2 The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hill	5,380,530	Jan. 10, 1995
Andersen et al. (Andersen)	5,487,902	Jan. 30, 1996
Gudas et al. (Gudas) (Published International Patent Application)	WO 98/23165	Jun. 4, 1998

Claims 1 through 22, 25 through 27, 30 through 34 and 37 stand rejected under 35 U.S.C. s 102(b) as anticipated by the disclosure of Hill. See the Office action dated July 29, 2004, page 2 and the Answer, page 3. Claims 28, 29, 35, 36 and 38 stand rejected under 35 U.S.C. s 103(a) as unpatentable over the combined disclosures of Hill, Andersen and Gudas. See the Office action dated July 29, 2004, pages 3 and 4 and the Answer, page 3.

OPINION

For the reasons set forth below, we reverse the examiner's s 102(b) rejection and remand the application to the examiner for appropriate action.

In order for a claimed invention to be anticipated under 35 U.S.C. s 102(b), the applied prior art reference must clearly and unequivocally disclose all of the elements of the claims on appeal, "**without any need for picking, choosing, and combining various disclosures**" therein. *In re Arkley*, 455 F.2d 586, 587-88, 172 USPQ 524, 526 (CCPA 1972).

Here, the prior art reference, Hill, relied upon by the examiner teaches a chewing gum comprising a gum base containing a flavoring agent and a sweetening/bulking agent coated with an emulsion coating containing one or more therapeutic substances. See column 15, lines 12-19 and column 18, line 10 to column 19, line 31. Hill then goes on to state (column 16, lines 6-13) that:

Other substances which may also be included in the chewing gum base mixture and which may also be added to the emulsion coating include: non toxic sources for acid such as adipic acid in combination with calcined kaolin [FN1], calcium carbonate, sodium carbonate, sodium bicarbonate, various phosphates, dicalcium phosphate, tetra sodium pyrophosphate, lecithin, lanolin, hydrolyzable tannin, silica, and the like. (Emphasis added.)

Hill further states (column 17, lines 1-11 and 56-59) that:

The high flavor levels which can be pleasantly incorporated into emulsion coatings of this invention...For example, natural and synthetic flavor and sweetener agents as diverse as menthol, xylitol and glycyrrhizin are known to be beneficial towards plaque control...

(Cite as: 2006 WL 1665466, *3 (Bd.Pat.App. & Interf.))

*3 ...

In addition to the buffering ingredients, the [emulsion coating] compositions of the invention can optionally contain at least one humectant selected from the group consisting of glycerine, xylitol, sorbitol and propylene glycol.

To arrive at the invention recited in the claims on appeal, one of ordinary skill in the art would have to **pick** and **choose** from a relatively broad disclosure of a large number of optional substances. Such **picking** and **choosing** has no place in making a Section 102 rejection for anticipation. **Arkley, 455 F.2d at 587-88, 172 USPQ at 526**; *In re Schaumann*, 572 F.2d 312, 315, 197 USPQ 5, 8 (CCPA 1978). Accordingly, we reverse the examiner's rejection of claims 1 through 22, 25 through 27, 30 through 34 and 37 under 35 U.S.C. § 102(b).

REMAND

Although some **picking** and **choosing** may have no place in making a Section 102 rejection, it may be entirely proper in making an obviousness rejection under Section 103. **Arkley, 455 F.2d at 587-88, 172 USPQ at 526**. The fact that Hill "discloses a multitude of effective combinations does not render any particular formulation less obvious." *Merck & Co. Inc. v. Biocraft Labs. Inc.*, 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989). Thus, based on the fact findings set forth above and in the Answer, we determine that Hill would have rendered the subject matter defined by claims 1 through 22, 25 through 27, 30 through 34 and 37 *prima facie* obvious within the meaning of 35 U.S.C. § 103(a).

The examiner has also determined that the combined disclosures of Hill, Andersen and Gudas would have rendered the subject matter defined by claims 28, 29, 35, 36 and 38 *prima facie* obvious within the meaning of 35 U.S.C. § 103(a). However, as is apparent from the Answer, the examiner has not addressed, *inter alia*, the rebuttal evidence relied upon by the appellants at page 7 the Reply Brief. According to the appellants (Reply Brief, page 7), the test results on pages 25 through 31 of the specification demonstrate that the claimed subject matter imparts unexpected results, thereby rebutting any *prima facie* case of obviousness established by the examiner.

It is well established that if a *prima facie* case is made in the first instance, and if the appellants come forward with reasonable rebuttal, e.g., experiment evidence, the entire merits of the matter are to be reweighed. *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986). In order to properly weigh the evidence of record, the examiner must determine whether the appellants have demonstrated that the test results relied upon are truly unexpected and are commensurate in scope with the degree of protection sought by the claims on appeal. *In re Merck & Co.*, 800 F.2d 1091, 1099, 231 USPQ 375, 381 (Fed. Cir. 1986); *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983); *In re Klosak*, 455 F.2d 1077, 1080, 173 USPQ 14, 16 (CCPA 1972). However, the examiner has done neither in this case. See the Answer in its entirety. Accordingly, we cannot ascertain the propriety of the examiner's Section 103(a) rejection of claims 28, 29, 35, 36 and 38 based on Hill, Andersen and Gudas and the appropriateness of any new Section 103(a) rejection against claims 1 through 22, 25 through 27, 30 through 34 and 37 based on the teachings of Hill.

*4 Thus, we return this application to the examiner to review the test data at pages 25 through 31 of the specification to determine whether the test results in question are sufficient to rebut any *prima facie* case of obviousness of the subject matter defined by all of the claims on appeal. If they do not meet the

(Cite as: 2006 WL 1665466, *4 (Bd.Pat.App. & Interf.))

requirements set forth in Klosak, Merck & Co., and Grasselli, respectively, as indicated *supra*, the examiner is to set forth a new ground of rejection against claims 1 through 22, 25 through 27, 30 through 34 and 37 under Section 103(a) and explain insufficiencies of the test results relied upon by the appellants pursuant to 37 CFR 41.50(a) and (b) (2004).

CONCLUSION

For the foregoing reasons, we reverse the examiner's decision rejecting claims 1 through 22, 25 through 27, 30 through 34 and 37 under 35 U.S.C. s 102, and remand the application to the examiner for appropriate action in view of our comments above.

This remand to the examiner pursuant to 37 CFR s 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR s 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

This application, by virtue of its "special" status requires an immediate action. Manual of Patent Examining Procedure s 708.01 (8th ed., August 2001). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REVERSED-IN-PART/REMANDED

BOARD OF PATENT APPEALS AND INTERFERENCES

CHUNG K. PAK

Administrative Patent Judge

CHARLES F. WARREN

Administrative Patent Judge

CATHERINE TIMM

Administrative Patent Judge

FN1. The terms "kaolin", "hydrolyzable tannin" and "various phosphates" include many clays, tannin compounds and phosphates.

2006 WL 1665466 (Bd.Pat.App. & Interf.)

END OF DOCUMENT

KeyCite Citing

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Database
FIP-PTO2006 WL 2725748 (Bd.Pat.App. & Interf.)
(Cite as: 2006 WL 2725748 (Bd.Pat.App. & Interf.))

*1 THIS OPINION WAS NOT WRITTEN FOR PUBLICATION
 Board of Patent Appeals and Interferences
 Patent and Trademark Office (P.T.O.)
 EX PARTE PATRICIA RUZAKOWSKI AND LUKE A. KUTILEK
 Appeal 2006-2511
 Application 10/693,463 Technology Center 1700
 Decided: September 20, 2006

Before WALTZ, TIMM, and JEFFREY T. SMITH
 Administrative Patent Judges
 JEFFREY T. SMITH
 Administrative Patent Judge

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1 and 3. Claims 4 to 10 have been withdrawn from consideration. (Br. 2). We have jurisdiction under 35 U.S.C. s 134.

We REVERSE.

BACKGROUND

The present invention relates to a coated article comprising a glass substrate and a copper oxide and manganese oxide coating over the substrate. The claim specifies that the copper-containing component and the manganese-containing component are present in an amount that provides a blue color in transmission. The Specification, page 3, discloses that if the copper component and the manganese component are not present in the appropriate ratios the color in transmission can vary from gray blue to amber. Claim 1, as presented in the Brief, appears below:

1. A coated article comprising:
 - a. a glass substrate; and
 - b. a copper oxide and manganese oxide coating over the substrate, the coating having the molar ratio of copper to manganese in the range of about 0.8 to 1.2 and a blue color in transmission.

The Examiner relies upon the following reference:

Stephens 5,593,134 Dec. 2, 1997 (Dec. 29, 1994)

Claims 1 and 3 stand rejected under 35 U.S.C. s 102(e) as anticipated by Stephens.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants regarding the above-noted rejection, we make reference to the Answer (mailed Apr. 5, 2006) for the Examiner's reasoning in support of the rejection and to the Brief (filed Sep. 12, 2005) for Appellants' arguments thereagainst. We REVERSE the Examiner's rejection. Our reasons follow.

OPINION

In order for the claimed invention to be anticipated under 35 U.S.C. s 102, all of the elements of the claim must be found in one reference. See Scripps Clinic and Research Found. v. Genentech, Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

It is the Examiner's position that Stephens discloses a pigment comprised of a substrate with a coating of copper and manganese oxides that can have a blue

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(Cite as: 2006 WL 2725748, *1 (Bd.Pat.App. & Interf.))

transmission color (Answer 4). The Examiner further asserts that the substrate can be made of glass. Id. We find that Stephens discloses interference pigments based on a platelet-like shaped substrate coated with titanium dioxide and additionally oxidic compounds of copper and manganese (Col. 1, ll. 1-4).

Stephens discloses that dark gray powder interference pigments are generated by forming oxidic compounds of copper and manganese on the surface of a titanium dioxide coated platelet-shaped substrate. These pigments are characterized by providing clean colors and an excellent hiding power. (Col. 1, ll. 53-62).

Stephens discloses a variety of platelet-shaped substrates which are suitable for the invention, including glass flakes (Col. 2, ll. 43-47). Stephens further discloses that pigments according to the disclosed invention can produce all desired interference colors (Col. 3, ll. 47-50). Exemplary colors produced are presented in Tables 1 and 2 of the reference.

*2 The Examiner asserts that Stephens discloses the claimed blue color based on the disclosure appearing in column 6 and Table 1 (Answer 3). The Examiner further asserts that the ratio of copper to manganese disclosed in Stephens meets the molar ratio of the claimed invention. [FN1]

For the purposes of anticipation, we must rely upon the interference pigments described in Tables 1 and 2. However, we cannot conclude that the claimed subject matter is anticipated by these teachings of Stephens.

With respect to the disclosure of the color values produced by the disclosed interference pigments, one would have to **choose** from the seven colors produced in Tables 1 and 2. In addition, Stephens discloses that these colors were achieved by coating the copper and manganese oxide on a titanium dioxide (rutile)/mica pigment. In other words, the color values appearing in Tables 1 and 2 are based upon a mica platelet-shaped substrate not a glass substrate as required by the claims. Also, the ratio for copper and manganese was adjusted to achieve the various color values described in Tables 1 and 2. Thus, to arrive at the present invention one would have to **choose** the glass flakes as the substrate in place of mica and **choose** the appropriate ratio for copper and manganese to achieve the claimed blue color. There is no indication that the same ratio for copper and manganese used to achieve the color values on a mica substrate would have been the same for a glass substrate. Based on the above findings, we conclude that in order to arrive at the claimed subject matter, a person having ordinary skill in the art would have to carefully **pick** and **choose** and combine the various disclosures among the teachings of Stephens to obtain a coated substrate (interference pigment) having the required components and blue transmission color required by the claimed subject matter. While **picking** and **choosing** may be entirely proper in making an obviousness rejection under 35 U.S.C. § 103, it has no place in making a rejection under 35 U.S.C. § 102 for anticipation. See *In re Arkley*, 455 F.2d 586, 587-88, 172 USPQ 524, 526 (CCPA 1972). Furthermore, we conclude that Stephens does not provide a disclosure with sufficient specificity to constitute a description of the claimed coated substrate within the purview of 35 U.S.C. § 102. See *In re Schaumann*, 572 F.2d 312, 315, 197 USPQ 5, 8 (CCPA 1978). Accordingly, we do not sustain the rejection of the claims on appeal under 35 U.S.C. § 102(e) as anticipated by Stephens.

CONCLUSION

The rejection under 35 U.S.C. § 102(e) is reversed.

REVERSED

PPG Industries, Inc.

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Westlaw

(Cite as: 2006 WL 2725748, *2 (Bd.Pat.App. & Interf.))

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FN1. The Appellants have not challenged the Examiner's position regarding the molar ratio. (See Brief generally).

2006 WL 2725748 (Bd.Pat.App. & Interf.)

END OF DOCUMENT